



UNITED STATES
PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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In re Application of :
Donald E. Gillespie :
Serial No.: 09/852,519 : PETITION DECISION
Filed: May 10, 2001 :
Attorney Docket No.: DEG-10002/29 :

This is a decision on the petition under 37 CFR 1.144, filed June 10, 2003, requesting review of a restriction requirement under 37 CFR 1.144.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained claims 1-21. The examiner mailed a first Office action to applicant on September 4, 2002, setting forth a restriction requirement, as follows:

- Group I, claims 1-8, drawn to a punctum plug;
- Group II, claims 9-15, drawn to a system for determining the position of a punctum plug;
- Group III, claims 16-21, drawn to an apparatus for viewing a punctum plug.

The examiner reasoned that Groups II and III were related as process and apparatus for its practice and that the process could be practiced by other apparatus, including by hand. Groups I and III were related as product and apparatus and that the product could be used with other apparatus. Groups I and II were related as product and process of use and the product could be used in other processes.

Applicant replied on December 2, 2002, electing Group I with traverse as to Group II. Applicant argued that there is no support for the examiner's statement that the process of positioning could be done with the unaided eye and that claim 9 depends from claim 1 and should not be separated from it.

The examiner mailed a non-Final Office action to applicant on February 26, 2003, maintaining the restriction requirement stating that claim 9 is a "methodology" claim (method of use) that can be practiced in other systems where no optical element is present. The requirement was made Final.

The examiner rejected claims 1-8 under 35 U.S.C. 112, second paragraph,, as indefinite. Claims 1-4 and 6 were rejected under 35 U.S.C. 102(b) as anticipated by L'esperance. Claims 1-8 were rejected as unpatentable over Seder et al or Freeman in view of Gwon et al.

Applicant replied on June 10, 2003, with an argument addressing the rejections of record and by filing this petition with respect to the restriction requirement.

DISCUSSION

Applicant argues that the restriction is improper and requests examination of withdrawn claims 9-21. Applicant points out that "claim 9 is an independent 'system' claim that makes reference to... claim 1 and 'at least one optical element.'" Applicant states that the examiner is incorrect in his argument that the claim is a methodology claim on several grounds, but fails to enumerate such grounds other than that claim 9 is not a methodology claim and that it requires an optical element. Applicant admits that the application admits that other systems may be used.

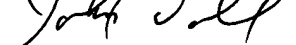
Careful review of the restriction requirement shows that the examiner has divided the claims into three statutory classes, product or article, process of using and apparatus for use. Even though claim 9 is not an "independent' claim, it is directed to an invention different from the product of claim 1. Mere inclusion of the product of a previous claim in a process claim does not require that the claims be examined together nor provide evidence that they are even closely related. No error is found in the examiner's restriction requirement.

DECISION

Applicants' petition under 37 CFR 1.144 is **DENIED**.

The application will be forwarded to the examiner for further consideration including consideration of the amendment filed June 10, 2003.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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